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EXAMINER

KING, JUSTIN

ART UNIT PAPER NUMBER

2111

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,349

Applicant(s)

TREE ET AL

Examiner

Justin I. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/7/04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 18's limitation is the first limitation of the claim 15.
2. Claims 19, 31 and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 19 and 36's limitations are the second limitation of the claim 15. Claim 31 merely states the purpose of the controlling interface.
3. Claim 38 is objected to because of the following informalities: Claim 38 recites "said controlling as" on claim 38's line 2. Applicant may have meant "said controlling interface as" instead of. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 15-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15 and 33 recite the limitations of "structurally adapted for manipulation"

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and "distinct" on the lines 2 and 4 of the claim 15's 2nd limitation and on limitations 4 and 5 of the claim 33. The metes and bounds for the claimed limitations cannot be properly construed; thus they render indefiniteness for the claim. Claims 16-32 and 34-39 are rejected because they incorporate claims 15 and 33's limitations.

The term "upgraded" in claims 24 and 38 is a relative term, which renders the claim indefinite. The term "upgraded" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15-29, 31, and 33-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Swindler et al. (U.S. Patent No. 5,313,596).

Referring to claim 15: Swindler discloses a case (figure 1, structure 14) for an electronic device (figure 1, structure 28), comprising: protective material (figure 1, structure 56) that maintains said electronic device within said case. Swindler's electronic device (laptop) has a keyboard and the associated circuitry to accommodate the keyboard's operations; the keyboard and the associated circuitry are the claimed user controls and control circuitry.

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Swindler's case includes an a controlling interface (figure 1, structures 50, 52, 66, and 68), said controlling interface having exterior user controls disposed on said protective material that are structurally adapted for manipulation by a user of said electronic device, said electronic device maintained within said case being controllable by said exterior user controls, said exterior user controls being separate and distinct from said user controls and control circuitry (figure 1). Hence, claim is anticipated by Swindler.

Referring to claim 16: Swindler's electronic device is operable separate and apart from the case.

Referring to claim 17: Swindler's electronic device is a computer processor.

Referring to claim 18: Swindler's electronic device is enclosed within said case.

Referring to claim 19: Swindler's exterior user controls (figure 1, structures 50, 52, 66, and 68) allow a user to operate said electronic device contained within said case.

Referring to claim 20: Swindler's case includes a eject switch (figure 1, structure 68) exclusively used by the case to eject the inserted electronic device; thus Swindler's eject switch produces command signals that operate functions that are not operated by the user controls and control circuitry.

Referring to claim 21: Swindler's case comprises a pocket portion (figure 1, structure 60 and 61) for accepting said electronic device, said electronic device being received within said pocket portion.

Referring to claim 22: Swindler discloses a connection port (figure 6, structure 44a) attached to said case, said connection port receiving said electronic device or being inserted into

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said electronic device, signals being transferred between said electronic device and said controlling interface by way of said connection port.

Referring to claim 23: Swindler discloses the potential lack of an expansion sound card due to the electronic device's small size (column 1, lines 47-50), and Swindler discloses it is known to connect the electronic device to additional peripheral device as needed (column 2, lines 45-48). Swindler further discloses his case (the docking station) is capable to provide additional peripheral devices to the inserted electronic device (column 2, lines 59-68), therefore Swindler implicitly discloses the case equipped with an audio speaker as one of the peripheral device.

Referring to claim 24: Swindler's docking station's controlling interface is used as an upgraded set of controls.

Referring to claim 25: Swindler's case includes a eject switch (figure 1, structure 68) exclusively used by the case to eject the inserted electronic device; thus Swindler's eject switch produces command signals that operate functions that are not operated by the user controls and control circuitry.

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Referring to claims 26-27: Claim 23's argument applies; furthermore, the case's connecting port (figure 6, structure 44a) is an integrated electronic jack to connect to additional peripheral devices.

Referring to claim 28: Claim 23's argument applies; furthermore, Swindler discloses the network peripheral (column 1, line 50), which is equivalent to the claimed modem.

Referring to claim 29: Swindler's case includes a power supply (figure 6, structure 86), which provides power to the inserted electronic device. Thus, the case's connecting port, which supplies the power to the inserted electronic device, is the claimed integrated electrical jack.

Referring to claim 31: Swindler's connecting port (figure 6, structure 44a) provides the electrical communication between said controlling interface and said electronic device.

Referring to claim 33: Swindler discloses maintaining an electronic device (figure 1, structure 28) within a case (figure 1, structure 14). Swindler's electronic device (laptop) has a keyboard and the associated circuitry to accommodate the keyboard's operations; the keyboard and the associated circuitry are the claimed user controls and control circuitry. Swindler's case includes exterior user controls of a controlling interface (figure 1, structures 50, 52, 66, and 68); and using said exterior user controls to control said electronic device maintained within said case, wherein said exterior user controls are structurally adapted for manipulation by a user of said electronic device, and wherein said exterior user controls are separate and distinct from said user controls and control circuitry. Hence, claim is anticipated by Swindler.

Referring to claim 34: Swindler's electronic device is operable separate and apart from the case.

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Referring to claim 35: Swindler's electronic device is a computer processor.

Referring to claim 36: Swindler's exterior user controls (figure 1, structures 50, 52, 66, and 68) allow a user to operate said electronic device contained within said case.

Referring to claim 37: Swindler's case includes a eject switch (figure 1, structure 68) exclusively used by the case to eject the inserted electronic device; thus Swindler's eject switch produces command signals that operate functions that are not operated by the user controls and control circuitry.

Referring to claim 38: Swindler's docking station's controlling interface is used as an upgraded set of controls.

Referring to claim 39: Swindler's case includes a eject switch (figure 1, structure 68), which produces command signals that operate functions that are not operated by the user controls and control circuitry.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Swindler and Frame (U.S. Patent No. 6,005,368).

Referring to claim 30: Swindler's disclosure is stated above. Although Swindler discloses that the inserted electronic device is battery-powered and the case also includes a power supply, Swindler does not explicitly disclose that the power is provided to store a charge. Frame discloses a docking station with charging capability (figure 1, column 3, lines 63-67, column 4, lines 1-12). Frame discloses a docking station charging the inserted laptop (abstract). Frame teaches that it is known to charge the laptop while it is docking on the docking station to reduce any laptop downtime. Hence, it would have been obvious to one having ordinary skill in the computer art at the time Applicant made the invention to adapt Frame's teaching onto Swindler because Frame enables one to maintain the charge in both laptop's battery and any backup battery to ensure the laptop's operations.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Swindler and Croft et al. (U.S. Patent No. 5,864,708).

Referring to claim 32: Swindler's disclosure is stated above. Swindler does not explicitly disclose a wireless means. Croft discloses a docking station with wireless means (figure 1).

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Croft teaches a wireless docking station to reduce the electromagnetic compatibility issues by eliminating the mechanical connection parts. Hence, it would have been obvious to one having ordinary skill in the computer art at the time Applicant made the invention to adapt Croft's teaching onto Swindler because Croft teaches one to efficiently connect a portable electronic device and a dock, and to minimized or eliminate the mechanical connection (column 2, lines 21-23).

***Response to Arguments***

12. Applicant's arguments with respect to previously presented and now cancelled claims 1-14 have been considered but are moot in view of the new ground(s) of rejection as stated above in responding to the newly added claims 15-39.

*Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

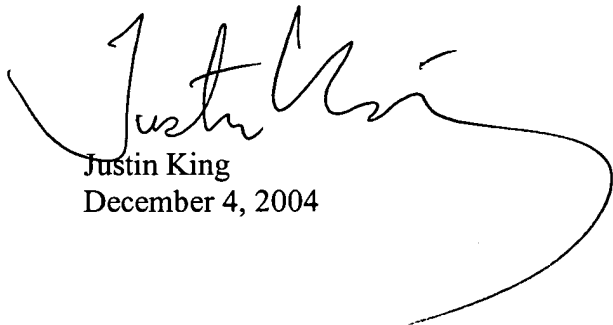
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin I. King whose telephone number is 571-272-3628. The examiner can normally be reached on Monday through Friday, 9:00 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 571-272-3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin King  
December 4, 2004



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